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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/801,233	03/16/2004	Ming Ta Hsu	24061.75 (TSMC2003.0374)	2017
42717 7590 09/10/2007 HAYNES AND BOONE, LLP 901 MAIN STREET, SUITE 3100 DALLAS, TX 75202			EXAMINER ROBINSON BOYCE, AKIBA K	
			ART UNIT 3628	PAPER NUMBER
			MAIL DATE 09/10/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

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Office Action Summary

Application No.

10/801,233

Applicant(s)

HSU ET AL.

Examiner

Akiba K. Robinson-Boyce

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>3/16/04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Status of Claims

1. Due to communications filed 3/16/04, the following is a non-final first office action. Claims 1-31 are pending in this application and have been examined on the merits. Claims 1-31 are rejected as follows.

Claim Objections

2. The numbering of claims is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not).

Misnumbered claims 27-34 have been renumbered 24-31. ***Double Patenting***

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir.

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1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-31 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-34 of copending Application No. 10/712880. Although the conflicting claims are not identical, they are not patentably distinct from each other because they both yield the same result of determining a price based on the quote amount associated with the product and the desired quantity of the product.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-2,4-12,14-20, and 22-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shavit (US 4,799,156).

As per claims 1, 19, Shavit discloses:

updating the quotation system including at least a first raw material product and its quote amount; storing the quote amount associated with the first raw material product/
providing the quotation system including at least a first raw material product and its quote amount; storing the quote amount, (Col. 11 line 52 – Col. 12 line 18, w/Col. 16, line 50 – Col. 17, line 2, w/Col. 33 line 28 – Col. 34 line 2, w/ Col. 40 lines 27 -35);

providing the product manufacturing facility demand planning system that identifies at least the first raw material product and desired quantity to produce a finished product/
providing the product manufacturing facility demand planning system that identifies at least the first product and desired quantity, (Col. 13 line 51 - Col. 14 line 9);

calculating a demand planning system price associated with the first raw material product by accessing the quote amount associated with the first raw material product

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from the quotation system, and determining the demand planning system price based on the quote amount associated with the first raw material product and the desired quantity identified in the product manufacturing facility demand planning system/ calculating a demand planning system price associated with the first raw material product by accessing the quote amount associated with the first raw material product, and determining the demand planning system price based on the quote amount associated with the first raw material product and the quantity required by the product manufacturing facility demand planning system to manufacture a finished product, (Col. 13 line 10 - Col. 14 line 9, w/Col. 25 lines 28 - 50).

Shavit does not specifically disclose the following: a semiconductor product manufacturing facility.

However, the nature of the facility and its particular industry is descriptive material and is not functionally involved in the recited steps of the method. Because it has no functional role in the method it is non-functional descriptive material, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983). MPEP 2106).

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As per claims 2, 13, 20, 27, Shavit does not specifically disclose the following: wherein the product manufacturing facility demand planning system comprises a semiconductor foundry.

However, the nature of the foundry and its particular industry is descriptive material and is not functionally involved in the recited steps of the method. Because it has no functional role in the method it is non-functional descriptive material, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); MPEP 2106).

As per claims 3, 14, 21, Shavit discloses:

wherein the quote amount is stored in a quotation system database, (Col. 12 line 54 – Col. 13 line 34, w/Col. 25 lines 28 -50, w/Col. 29 line 31 - Col. 30 line 2, w/Col. 33 line 28 - Col. 34 line 2, w/Col. 36 lines 22 - 53, w/Col. 39 lines 1-4, w/Col. 40 lines 5-17).

As per claims 4, 15, 22, Shavit discloses:

storing information associated with the first raw material product in a product database/
storing predetermined information associated with the first raw material product and second raw material product in respective raw material product database records, (Col. 2 lines 9-15, Col. 7 lines 6-22, Col. 25 line 51 - Col. 26 line 4, Col. 40 lines 28-35);

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As per claim 5, Shavit discloses:

updating a mapping system with information from the quotation system database and the product database associated with the first raw material product, (Col. 24 line 53 - Col. 25 line 9, Col. 31 line 32 - Col. 32 line 9, Col. 36 lines 22-53, Col. 40 lines 28-35);

As per claims 6-9, 16-18, 29, 30, Shavit discloses:

wherein the mapping database is updated automatically when the quotation system database is changed/wherein the mapping database is updated automatically when a new quotation is entered into the quotation system database utilizing a database trigger/ wherein the mapping database is updated automatically when a new quotation is entered into the quotation system database utilizing a auto-call function/ wherein the mapping database is updated automatically when the product database is changed, (see at least column 24 line 53 - column 25 line 9, column 31 line 32 - column 32 line 9, column 36 lines 22-53, column 40 lines 28-35. In the present case, utilizing database triggers or auto-call functions is inherent in automatic database updating).

As per claims 10, 11, 12, 23, Shavit discloses:

receiving a quote amount for a second raw material product;
storing the quote amount associated with the second raw material product/ providing the quotation system with at least two raw material products and their respective quote amounts; storing the two quote amounts/a quotation system entry device for entering a quotation entry that includes at least two raw materials and their quote amounts;

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memory connected to the data entry device configured to receive the quote amounts, (Col. 11 line 52 - Col. 12 line 18, Col. 16 line 50 - Col. 17 line 2, Col. 33 line 28 - Col. 34 line 2, Col. 40 lines 27 - 35);

providing the product manufacturing facility demand planning system that identifies at least the two raw material products and their respective desired quantities/a demand planning system entry device for entering a finished product and required raw material products and desired quantities, (Col. 13 line 51 - Col. 14 line 9);

calculating a demand planning system price associated with the second raw material product, wherein the demand planning system identifies at least the first raw material product and the second raw material product prices and desired respective quantities, by accessing the stored quote amount associated with the second raw material product, and determining the demand planning system price for the second raw material product based on the stored quote amount associated with the second raw material product and the desired quantity identified in the product manufacturing facility demand planning system/ wherein the quote amount associated with the first raw material product and the quote amount associated with the second raw material product are in the same quotation system/calculating demand planning system prices associated with the at least two raw material products by accessing the quote amounts associated with the products, and determining the demand planning system prices based on the respective quote amounts associated with the products and their respective desired

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quantities identified in the product manufacturing facility demand planning system/a price calculator configured to receive the desired quantities of raw materials from the demand planning system entry device, to access the memory to identify the quote amounts associated with the raw materials, and to calculate a price for the finished product based on the desired quantities and quote amounts of raw materials, (Col. 12 line 54 - Col. 14 line 9, Col. 25 lines 28 - 50, Col. 29 line 31 - Col. 30 line 2, Col. 33 line 28 - Col. 34 line 2, Col. 36 lines 22 - 53, Col. 39 lines 1-4, Col. 40 lines 5-17).

As per claim 28, Shavit discloses:

a quotation system database connected to the demand planning system entry device, (Col. 12 line 54 – Col. 13 line 34, w/Col. 25 lines 28 -50, w/Col. 29 line 31 - Col. 30 line 2, w/Col. 33 line 28 - Col. 34 line 2, w/Col. 36 lines 22 - 53, w/Col. 39 lines 1-4, w/Col. 40 lines 5-17).

; a product database configured to receive raw material product information, (Col. 2 lines 9-15, Col. 7 lines 6-22, Col. 25 line 51 - Col. 26 line 4, Col. 40 lines 28-35); and a mapping database that interfaces with both the quotation system database and product database capable of storing information associated with the raw material products, (Col. 24 line 53 - Col. 25 line 9, Col. 31 line 32 - Col. 32 line 9, Col. 36 lines 22-53, Col. 40 lines 28-35).

As per claim 31, Shavit discloses:

wherein the quotation system entry device and the demand planning system entry device comprise a single device (Abstract, column 5 lines 16-65, column 13 line 51 -

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column 14 line 9, in this case, virtually every function performed can be performed by the same device).

5. Claims 32-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shavit (US 4,799,156), and further in view of Senior (US 2002/0029171).

As per claims 32-34, *Shavit does not specifically teach the following:*

wherein the single device is a personal data assistant/wherein the quotation system entry device is connected to the memory via a wireless connection/ wherein the demand planning system entry device is connected to the price calculator via a wireless connection.

But does teach that every function performed can virtually be performed by the same device in the Abstract, column 5 lines 16-65, column 13 line 51 -column 14 line 9.

However, discloses:

the single device being a personal data assistant, the quotation entry device connected to the memory via a wireless connection, and the order entry device connected to the price calculator via a wireless connection ([0063]).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the system of Shavit and Banks to include the single device being a personal

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data assistant, the quotation entry device being connected to the memory via a wireless connection, and the order entry device being connected to the price calculator via a wireless connection as taught by Senior, in order to improve the convenience of using of the system, make the system more accessible, and make the system easier to use, thereby attracting more users to the system and increasing commerce using the system.

Conclusion

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Akiba K Robinson-Boyce whose telephone number is 571-272-6734. The examiner can normally be reached on Monday-Friday 9am-5:30pm.

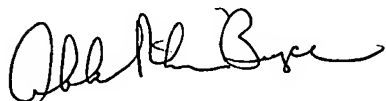
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Hayes can be reached on 571-272-6708. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the

•Patent Application Information Retrieval (PAIR) system, Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

A handwritten signature in black ink, appearing to read "A. R. B.", with a stylized, cursive script.

A. R. B.

September 4, 2007.